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P.O. Box 19928
Alexandria, VA 22320

In re Application of	:	
DENIS, Roger	:	
U.S. Application No.: 09/857,144	:	
PCT No.: PCT/FR99/01369	:	COMMUNICATION
International Filing Date: 09 June 1999	:	REGARDING SUBMISSION
Priority Date: 08 December 1998	:	UNDER 37 CFR 1.42
Attorney's Docket No.: 109684	:	
For: SAFETY ASSEMBLY FOR A SYRINGE PRE-	:	
FILLED WITH LIQUID, IN PARTICULAR A	:	
MEDICINE	:	

This communication is issued in response to applicant's submission on 03 August 2001 of a declaration executed on behalf of the deceased inventor, which has been treated as a submission under 37 CFR 1.42.

BACKGROUND

On 09 June 1999, applicant filed international application PCT/FR99/01369 which claimed a priority date of 08 December 1998 and which designated the United States. On 15 June 2000, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 07 July 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 08 June 2001.

On 01 June 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 03 August 2001, applicant filed the declaration considered herein. This declaration was executed on behalf of the deceased inventor by the Executor of the inventor's estate, and it was accompanied by payment of the \$130 surcharge for filing the declaration after the thirty month deadline.

On 05 September 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for

providing the oath or declaration later than thirty months from the priority date were required. The Notification was apparently mailed before the declaration and surcharge submitted by applicants on 03 August 2001 was matched to the application file.

On 31 July 2001, applicants filed a response to the Notification Of Missing Requirements which referred to the previously filed declaration and included a copy of the declaration and a stamped return postcard.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

37 CFR 1.497(b)(2) requires that citizenship, mailing address, and residence information be provided for **both** the deceased inventor and the legal representative. The regulation expressly requires the inclusion of this information for the legal representative. As for the deceased inventor, such information is required because the legal representative must declare to all the facts which the inventor would have been required to state, and citizenship, residence and mailing address are among the facts which the inventor would have been required to set forth pursuant to 37 CFR 1.497(a) and 37 CFR 1.63.

The declaration submitted on 03 August 2001 was executed by a person identified as the "Executor" of the deceased inventor's estate, the proper person to execute the declaration under 37 CFR 1.42 (although the name of this person is not clearly set forth in the declaration). However, the declaration only sets forth one residence, post office address, and citizenship. It is not clear whether this information is for the deceased inventor or for the Executor. Regardless of who this information pertains too, the declaration is defective because, as discussed above, the residence, post office address and citizenship information is required for both the deceased inventor and the Executor.

Because the declaration filed on 03 August 2001 does not provide all the required information, the declaration is not in compliance with 37 CFR 1.497(b)(2) and cannot be accepted under 37 CFR 1.42.

CONCLUSION

The 03 August 2001 submission under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment.

A proper response must include an acceptable declaration properly executed under 37 CFR 1.42, and the declaration must include all required information, including the citizenship, post office address, and residence information for the deceased inventor and the Executor, as discussed above.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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